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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,084	06/29/2001	Jason Benfield	AUS920010375US1	6717
35525	7590	10/14/2011		
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER DALENCOURT, YVES	
			ART UNIT 2457	PAPER NUMBER
			NOTIFICATION DATE 10/14/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[ptonotifs@yeciipaw.com](mailto:ptonotifs@yeciipaw.com)

**Office Action Summary****Application No.**

09/895,084

**Applicant(s)**

BENFIELD ET AL.

**Examiner**

YVES DALENCOURT

**Art Unit**

2457

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 July 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 1-30 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☒ Claim(s) 1-20 is/are allowed.
- 7) ☒ Claim(s) 21-30 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

This office action is responsive to amendment filed on 07/11/2011.

#### ***Response to Amendment***

The Examiner has acknowledged the amended claims 1 – 3, 11 – 15, 17, 19, and 20 – 23.

#### ***Response to Arguments***

Applicant's arguments, see amendment, filed on 07/11/2011, with respect to the 35 U.S.C. 112 second and sixth paragraph, the 102 and 103 rejections of claims 1 - 30 have been fully considered and are persuasive. The rejection of claims 1 - 30 has been withdrawn. However, the 35 U.S.C. 101 rejection is maintained.

Regarding Applicants' argument (page 9), that Applicants disavow that portion of the scope of computer readable medium Claims 21-30 that would otherwise cover transitory signals. Claim scope covering other forms of computer readable media (besides transitory signals) that allow Claims 21-30 to meet the requirements of 35 U.S.C. 101 is not intended to be disavowed by the statements herein. Therefore the rejection of Claims 21-30 under 35 U.S.C. § 101 has been overcome.

The Examiner respectfully disagrees with Applicants' assertion as far as the medium is concerned. Therefore, the 101 rejection is maintained.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Applicants' disclosure (paragraph [0228]), it is found that the "computer readable medium" covers both forms of non-transitory media and transitory propagating signals per se. Thus, claim 21 non-statutory at least for the reasons that they include, as a whole, a "signal" that does not fall into any statutory category of invention under 35 U.S.C. 101 and non-functional printed matter in the form of a "literary work".

It is suggested to amend the claim as follows: A **"non-transitory computer readable storage medium"**---; or a **"computer readable storage device"**; a **"computer readable storage memory"**; or enter after medium (line 2) --- , **wherein the medium is not signal**, --- in order to direct the claims to statutory subject matter. Also the computer program product needs to be stored on the medium.

Claims 22 – 30 are necessarily rejected as being dependent upon the rejection of claim 21.

***Allowable Subject Matter***

Claims 1 – 20 are allowed.

### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YVES DALENCOURT whose telephone number is (571)272-3998. The examiner can normally be reached on M-F 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/YVES DALENCOURT/  
Primary Examiner, Art Unit 2457